REMARKS

In the previous Office Action, the Examiner objected to informalities in the specification and claims. The above amendments are believed to provide appropriate correction.

The Examiner rejected all claims due to either 35 U.S.C. 102(b) or 35 U.S.C. 103(a). The Applicant has amended independent claims 1, 56, and 64 and cancelled claims 8, 10, 11, 26-28, 60-62, 66 and 68. The Applicant believes that these amendments place all remaining claims, 1-7, 9, 12-25, 56-59, 63-65, 67 and 69-70, in condition for allowance, in light of the arguments below, and respectfully requests the Examiner to reconsider and allow these claims.

The Examiner rejected claims 1-7, 9, 14-16, 18-20, 24, 25, 56-57, 59, 63-65, 67 and 69 under 35 U.S.C. 102(b) due to Young et al. (US 5,817,017). The Examiner also rejected claims 8, 10, 11, 17, 21-23, 26-28, 60-62, 66, 68 under 35 U.S.C. 103(a) due to Young et al. by itself. With reference to some of these claims (apparently 8, 10, 11, 26-28, 60-62, 66 and 68), the Examiner noted that "Young et al. fails to specifically disclose where the different materials are deposited", but supported the finding of obviousness allegedly "because Applicant has not disclosed that such placement of the material provides an advantage, is used for a particular purpose, or solves a stated problem."

However, this assertion is objectively contradicted by the text of the application. For example, on page 18, lines 3 through 22 can be found a disclosure of how such placement of the material provides an advantage, is useful for a particular purpose, and solves a stated problem. As a particular example, part of this selection reads:

> "Placement of MR [i.e., magnetic resonance] material 450 within or on the inside of body 435 has certain

> illustrative advantages. For example, during use of device 200, there generally may be less fluid exchange in the inner lumen of body 435 than on the external or outside surface of body 435. In the context of embodiments wherein paramagnetic ions are incorporated with a hydrophilic polymer, losses of paramagnetic material from the hydrophilic polymer could be decreased in the case of placement of MR material within or on the inside of body 435. Such placement might enable a better longevity of the magnetic resonance visibility effects."

The application therefore discloses that such placement of the material provides an advantage, is used for a particular purpose, and solves a stated problem, in specific contradiction of the rationale for the §103 rejection of the corresponding claims.

The Examiner found furthermore that one of ordinary skill in the art "would have expected Applicant's invention to perform equally well with any manner in which the material is disposed because both perform the same function of allowing the medical device to be visualized under MRI equally well." This concession by the Office is specifically contradicted in the application, in the same section, which teaches a particular advantage that the Office has conceded would go contrary to the expectations of one of ordinary skill in the art. The Examiner's concession therefore strengthens Applicant's position that this feature would be unexpected and surprising to one of ordinary skill in the art, and therefore contradicts a finding of obviousness.

Because the rationale for finding these claims obvious is thereby contradicted in fact, Applicant respectfully requests the Examiner to reconsider this finding. Applicant has also

cancelled claims 8, 10, 11, 26-28, 60-62, 66 and 68, and amended claims 1, 56, and 64 to include limitations relevant thereto. Because the new independent claims 1, 56, and 64 have been amended to include limitations which are indicated to be non-obvious under the reasoning above, among other reasons, Applicant respectfully requests the Examiner to reconsider the rejection of claims 1, 56 and 64, and to allow the same.

Claims 2-7, 9, 14-16, 18-20, 24, and 25 are dependent on the newly amended claim 1; claims 57, 59 and 63 are dependent on the newly amended claim 56; and claims 65, 67 and 69 are dependent on the newly amended claim 64. Applicant believes these dependent claims are also in condition for patentability, the reasons for which include that each is dependent on claims 1, 56 or 64, which have been amended as discussed above. Applicant therefore respectfully requests that the Examiner reconsider and allow claims 2-7, 9, 14-16, 18-20, 24, 25, 57, 59, 63, 65, 67 and 69.

Claim 14 is included in the Examiner's rejection under §102(b) in view of Young, though its elements are not specifically discussed. Applicant believes the elements of claim 14 are not disclosed by Young, and that this claim was improperly included in the rejection under §102(b).

Specifically, Applicant finds no mention of co-extrusion in the entire disclosure of Young. Claim 14 defines an elongated medical device wherein the extrusion material is a co-extrusion material that comprises first and second co-extrusion components, as defined particularly in claim 14. Since Young does not make any disclosure of co-extrusion, of co-extrusion materials, of co-extrusion components, or of anything that apparently discloses these elements under alternative terminology, it is not believed that the allegation that Young anticipates this claim is supportable.

Applicant therefore respectfully requests, on this separate rationale among others, that the Examiner reconsider and allow claim 14. Accordingly, since claims 15-25 are dependent on claim 14, Applicant also respectfully requests that these claims be reconsidered and allowed together with claim 14.

The Examiner singled out claim 17 in particular in the rejection under §103, wherein the Examiner asserted without reference that the process of cross-linking material to enhance durability was obvious. Claim 17 defines an elongated medical device defined by parent claims, wherein the co-extrusion material is cross-linked so as to provide an enhanced durability. Among the basic requirements for a prima facie case of obviousness is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. § 2143 (Edition 8, Revision 1, Feb. 2003). The Examiner has not provided Applicant with a prior art reference teaching or suggesting the limitations of claim 17, including an elongated medical device wherein the co-extrusion material is cross-linked so as to provide an enhanced durability.

Applicant believes that the unsupported assertion that the limitations of claim 17 fall into "well known" prior art is inappropriate, because such a factual determination is subject to the possibility of disagreement among reasonable people, and should not comprise the principle evidence upon which a rejection is based. See M.P.E.P. § 2144.03. Applicant believes that when the elongated medical device defined by claim 17 is considered in its entirety, rather than its individual elements being considered piecemeal, it is not obvious in view of the prior art, and respectfully requests the Examiner to reconsider this rejection accordingly. Applicant believes that this reasoning applies as well to the rejection of claims 21-23, and includes those claims for the Examiner to reconsider and allow together with claim 17.

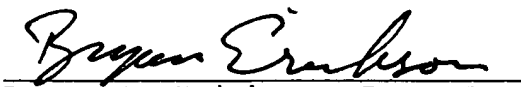
Claims 6 and 25 were among those for which the Examiner cited a specific passage within Young to show anticipation under 35 U.S.C. 102(b). Applicant finds, however, that Young nevertheless does not anticipate these claims. While Young discloses, for example, ethylenediamine diacetic acid, Young does not disclose a substance having a plurality of paramagnetic ions comprising a gadolinium diethylenetriaminepentaacetic acid material. The absence of this element of claims 6 and 25 in Young is one reason why claims 6 and 25 should not be subject to a rejection under §102 based on Young. Applicant respectfully requests the Examiner to find accordingly.

The Examiner rejected claim 58 under 35 U.S.C. 103 due to Young et al. (US 5,817,017) in view of Weber et al. (US 5,728,079), and rejected claims 12, 13 and 70 under 35 U.S.C. 103 due to Young et al. (US 5,817,017) in view of Gillies et al. (US 6,272,370). Claims 12, 13, 58 and 70 are each dependent on one of claims 1, 56, and 64, each of which have been amended. Applicant believes those amendments provide one reason, among others, why claims 12, 13, 58 and 70 are in patentable condition, and respectfully requests the Examiner to reconsider and allow these claims.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Bryan F. Erickson, Reg. No. 51,655
Suite 1600 - International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222 Fax: (612) 334-3312